

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/392,585
Attorney Docket No. Q55716

REMARKS

Reconsideration and allowance of the above-identified application are respectfully requested in view of the foregoing amendments and the remarks hereinbelow.

Pending claims:

Claims 1-4, 6-11, and 14-17 are pending. Claims 14-17 have been newly added and claim 13 has been cancelled.

Formal issues:

1. Claims 1-4, 6-11, and 13 were rejected under 35 U.S.C. § 112, first paragraph, as being based on allegedly non-enabling disclosure. Applicants respectfully traverse.

Applicants have just detected a translation error as between the present application and the French priority document, the permissible correction of which should at least partially address the issues raised by the Examiner. This problem specifically concerns the use of the English words "acquires," "acquisition," and the like in the present application. The corresponding terms in the French priority document

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are the verb “saisir” and the noun “saisie.” See, in the French priority document, for example at page 2, line 25 (“saisit” is a conjugated form of the verb saisir), corresponding to page 2, line 23 of the present application; page 3, line 11 (“une étape de saisie”) corresponding to page 3, line 8 of the present application (“a step of acquisition”); page 5, lines 24-25 (“la saisie précédente”) corresponding to page 5, line 18 of the present application (“(the preceding acquisition)”; etc.

One meaning of these words in English is “to acquire” or “acquisition.” However, another (and in this case, appropriate) sense is “to input data” or “data entry.” This sense of the word is supported in the originally filed application in view of, for example, Figure 2, in which steps 120 and 140 (updating index for printing heads 1 and 2, respectively) clearly indicate a direction of action from supervision terminal 60 to management server 50. The corresponding written description states, for example, “In a step 120, the user selects a first traditional printing head of which he wishes to update the index and enters via the keyboard of the terminal the new current index.” (Page 5, line 26 to page 6, line 1. Emphasis added.) However, claim 1 as filed (alternatively) recites, in part, “proceeding with an exchange of data between the [supervision] terminal and the [management] server during which the user acquires at the supervision terminal a current invoicing index relative to the at least one off-line franking machine...” (Emphasis added.)

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Applicants propose to amend the application to change occurrences of "acquire" and "acquisition" and the like to more accurately recite "input" or "inputting" or the like as may be appropriate. No new matter is added thereby, in view of the foregoing explanation.

As for the Examiner's specific comments:

a. exchange of information between the "traditional" franking machines and the supervision terminal:

The Examiner inquires how the current invoicing index and a franking authorization code are exchanged between a given traditional franking machine and the supervision terminal.

With respect to the current invoicing index that is, broadly, transmitted from the given traditional franking machine to the management server, Applicants respectfully point out that the originally filed application discloses that a user enters, via the keyboard of the supervision terminal, the current invoicing index. See, for example, page 5, line 26 to page 6, line 1, and Figure 2, step 120 as illustrated.

With respect to the franking authorization code being transmitted to the given traditional franking machine, the originally filed application discloses at, for example, page 8, lines 7-18, a process by which an internally calculated franking authorization code is compared to the franking authorization code "furnished by the server and then

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communicated manually by the user to the franking machine (through his user interface)" (emphasis added).

Applicants note that claim 1 as amended no longer recites "acquires at a supervision terminal," thereby fully mooting the Examiner's comments regarding undue experimentation.

b. electrical isolation from the network:

Applicants propose herein to revert to claim language closer to what was originally filed, as it appears that the recitation of "electrically isolated" is not having its intended effect of clarifying the subject matter being claimed. Specifically, claim 1 as amended herein recites "A process for monitoring a plurality of franking machines, wherein at least one of the franking machines is connected to a public communications network and at least another one of the franking machines is not connected to the public communications network". This recitation is believed to be technically accurate, supported by the originally filed application (see, for example, Figure 1), and in agreement with past discussions with the Examiner on this issue (for example, in view of the July 2002 personal interview with the Examiner in which a positive recitation of a networked franking machine was suggested in addition to the recitation of a franking machine not connected to the network).

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In view of the foregoing, the Examiner's comments raised with respect to 35 U.S.C. § 112, first paragraph, are believed fully addressed and overcome. Withdrawal is therefore believed appropriate. However, should the Examiner feel that any issues remain in this regard, Applicants would welcome a telephonic indication to that effect to their undersigned representative.

2. Claims 1-4, 6-11, and 13 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

With respect to the recitation of the claimed supervision terminal, claim 1 as amended is believed to recite the supervision terminal in a manner commensurate with the Examiner's comments.

With respect to the recitation of "receives a code of authorization" in claim 1, the Examiner states that it is unclear "how the code of authorization is received or has been received from the at least one of the isolated franking machines." Applicants respectfully note that the supervision terminal receives the code of authorization from the management server. See, for example, Figure 2, elements 130 and 150. Applicants also note that the originally filed application states "The different codes of authorization to frank may then be introduced manually by the user at the level of the franking machines provided with the printing heads" (page 6, lines 16-18).

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The Examiner also inquires, "Is this authorization done for each franking operation?" Applicants understand the Examiner to be asking if the receipt of the code of authorization from the management server occurs for each franking operation. In this regard, Applicants draw the Examiner's attention to the explanation at, for example, page 6, line 19 to page 7, line 9.

With regard to the recitation of "displaying, at the supervision terminal (1) a list of the plurality of franking machines" in claim 1, Applicants note that the recitation of "the plurality of franking machines" has not been limited by scope-reducing language such as "some of the plurality" or the like, and as such should be understandable as encompassing the whole of the initially recited plurality of franking machines, including franking machines both connected and not connected to the public communications network.

With regard to the recitation of "a last invoicing index," Applicant notes the description at, for example, page 6, lines 3-8, which explains that a first code of authorization to frank is obtained from known data such as the serial number of the printing head in question and the current invoicing index. Applicants trust that this addresses the Examiner's question, but would be happy to provide any further clarification required.

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In view of the foregoing, it is believed that all issues raised by the Examiner under 35 U.S.C. § 112, second paragraph, have been fully addressed and overcome. Withdrawal is therefore believed appropriate.

Rejections based on prior art:

1. Claims 1, 4, 7-11, and 13 were rejected under 35 U.S.C. § 103(a) as being obvious over LeCarpentier, in view of the allegedly well-known prior art, further in view of Kim et al.

The proposed combination of references is improper for at least the following reasons.

First, the system in LeCarpentier operates on the premise that all of the franking machines 1 are connected to respective local stations 4. For example, the abstract of LeCarpentier states "Each franking head is connected to a local concentrator station (4) via a data transmission link (11)."

At column 2, lines 58-66, LeCarpentier states "Each local station 4 permanently interrogates the franking machines connected thereto in order to update an image of the meters in the machines, regardless of the status thereof, so as to [be] ready at any moment to supply the central station 2 with up-to-date information." Applicants in

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particular note the mention of being ready "at any moment" to supply the central station 2 with "up-to-date information."

Finally, Applicants note that claim 1 in LeCarpentier states "each franking head (8) is connected to a concentrator local station (4) via a data transmission link."

In view of the foregoing, it is clear that the various franking machines 1 in LeCarpentier communicate, ultimately, with central station 2 by virtue of the fact that they are all connected to respective data transmission links 11. No contemplation of a functioning system in which a franking machine 1 is not connected to a data transmission link is apparent. Therefore, if the combination of LeCarpentier, the noted allegedly well-known knowledge in the art, and Kim et al. were made, the resultant combination (including notably at least one franking machine not connected to a network) would render LeCarpentier unsatisfactory for its expressly stated intended purpose, including, without limitation, being able to provide "up-to-date information" about the franking heads "at any moment." It is well-settled that if "the prior art invention being modified [is rendered] unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the modification." See, for example, MPEP § 2143.01, citing *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984). Reliance on the part of Kim et al. noted by the Examiner would render LeCarpentier particularly unsatisfactory for its intended purpose as it would at least generally result in a system

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wait for input, instead of allowing information updating ready at any moment, as in LeCarpentier as set forth.

In the alternative, the modification of LeCarpentier as proposed by the Examiner would change the principle of operation disclosed therein. Such a result indicates that the teachings of the relied upon art are insufficient to establish a *prima facie* case of obviousness. See, again, MPEP § 2143.01, citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (particularly mentioning the fact that the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." 270 F.2d at 813, 123 USPQ at 352.). In the same manner mentioned in *Ratti*, the provision of a franking machine not connected to the network illustrated in LeCarpentier would require substantial reconstruction and redesign of the elements in order to accommodate the resultant communication requirements shown, as well as a change in the basic principle under which the primary reference construction was designed to operate.

Even if the proposed combination of references were proper, it would fail to arrive at the invention as set forth in amended claim 1.

To the extent the Examiner may consider it still applicable to claim 1 as amended, Applicants respectfully traverses the Examiner's taking of official notice with

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respect to the limitation "via at least one supervision terminal from which the plurality of franking machines is independent" in accordance with MPEP § 2144.03. MPEP § 2144.03 clearly contemplates seasonable traversal of such an assertion by the Examiner, and states that "If the applicant traverses such an assertion [of official notice] the examiner should cite a reference in support of his or her position." Accordingly, a citation of prior art is respectfully requested, bearing in mind that if indeed "this limitation was well known in the networking art at the time the invention was made," it should be by definition very easy for the Examiner to provide an appropriate citation.

The relied upon references, alone or in combination (with or without regard to the taking of official notice), fail to teach or suggest at least process for monitoring a mixed plurality of franking machines (i.e., at least one of the franking machines being connected to a public communications network, and at least another one of the franking machines being not connected to the public communications network), utilizing a supervision terminal as claimed "wherein the supervision terminal is independent from the plurality of franking machines."

The remaining relied upon references, either alone or in combination (with or without regard to the taking of official notice), also fail to teach or suggest exchanging data between a supervision terminal and a management server, including transmitting a current invoicing index corresponding to the at least one franking machine not

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connected to the public communications network to the management server. The Examiner admits that LeCarpentier does not disclose this feature. See, for example, part 7 of the Official Action. Notwithstanding the vague comments at part 8 of the Official Action concerning Kim et al., Applicants note that the Examiner never establishes (in accordance with 35 U.S.C. § 103(a) that the references, alone or in combination, teach or suggest this feature. Applicants further note that the "current invoicing index" is not the "last invoicing index." See, for example, page 1, lines 7-9; and page 5, line 17. Also, there is no evident basis for interpreting the "access code" mentioned in Kim et al. as corresponding to an invoicing index as disclosed and claimed in the present application.

Finally, the remaining relied upon references, either alone or in combination (with or without regard to the taking of official notice), also fail to teach or suggest displaying, at the supervision terminal, a list of the plurality of franking machines and a last invoicing index validated by the management server for each of the plurality of franking machines. Contrary to the Examiner's reliance on Kim et al. in part 8 of the present Official Action, Kim et al. do not disclose or even suggest the display of any invoicing index, and certainly not the last invoicing index validated by the management server for each of the plurality of franking machines. See, especially, column 8, lines 53-67 as cited by the Examiner.

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In summary, the combination of references and allegedly well-known knowledge in the art proposed by the Examiner is therefore improper for the reasons stated. However, even if the combination of references proposed by the Examiner were made, the resultant combination would still fail to arrive at the invention recited in claim 1. Accordingly, claim 1 is believed patentable over the relied upon combination of references, as are the respective pending claims depending therefrom.

In addition, Applicants traverse the rejection of claim 8, as amended. Kim et al. do not teach or suggest a code of authorization to frank obtained by a calculation based on a current invoicing index. Kim et al. state that "Data processing center 30 responds to a message to generate a unique recharge code as a secure function of the access code, meter identification, and recharge amount, and debits the recharge amount to the identified account." (Column 6, lines 19-23.) No mention is made of a calculation based on a current invoicing index.

Applicants also traverse the rejection of claim 9. Kim et al. clearly state "Data processing center 30 responds to a message to generate a unique recharge code as a secure function of the access code, meter identification, and recharge amount, and debits the recharge amount to the identified account." (Column 6, lines 19-23.) There is no mention of calculating the claimed code from a current date, as claimed.

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Applicants traverse the rejection of claim 10 as set forth. The noted portion of Kim et al. relied upon by the Examiner has no relevance to the generation of a code of authorization to frank, as claimed.

Applicants also traverse the rejection of claim 11. The noted portion of LeCarpentier does not vocal synthesis telephonic communication, as claimed.

Claim 13 has been cancelled, rendering the rejection thereof moot.

2. Claims 2 and 3 were rejected under 35 U.S.C. § 103(a) as being obvious over the combination of LeCarpentier, the allegedly well known knowledge in the art mentioned, and Kim et al., further in view of Gerszberg et al.

Gerszberg et al. add no teaching or suggestion that would overcome the deficiencies noted above with respect to independent claim 1. Therefore, independent claim 1 remains patentable over the expanded combination of art relied upon by the Examiner, and claims 2 and 3 are allowable at least by their dependence from claim 1.

3. Claim 6 were rejected under 35 U.S.C. § 103(a) as being obvious over the combination of LeCarpentier, the allegedly well known knowledge in the art mentioned, and Kim et al., further in view of Breault et al.

Breault et al. add no teaching or suggestion that would overcome the deficiencies noted above with respect to independent claim 1. Therefore, independent

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claim 1 remains patentable over the expanded combination of art relied upon here by the Examiner, and claim 6 is allowable at least by its dependence from claim 1.

New claims:

Applicants have added new claims 14 through 17. Applicants note that the Examiner has examined all of the features of these claims previously, and therefore, a new search should not be necessary in order for the Examiner to review these newly added claims.

New dependent claim 14 simply breaks apart the two parts of dependent claim 2, and depends from claim 2. Claim 14 is patentable over the relied upon art for reasons similar to those set forth relative to claim 2.

New independent claim 15, and dependent claim 16 include similar features as independent claim 1 substantially as amended in the October 27, 2003 Amendment. There are certain additional differences in claim 15, taking into account certain changes made in accordance with the response to the rejections set forth above under 35 U.S.C. § 112, first and second paragraph.

Claims 15 and 16 are patentable over the relied upon art for reasons similar to those set forth above relative to claim 1. Specifically, the proposed combination cannot be properly made under 35 U.S.C. § 103(a) in view of *In re Gordon* and *In re Ratti*. Furthermore, even if the combination were made, the taking of official notice with

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respect to the claimed supervision terminal is traversed. Also, the resultant combination fails to arrive at the claimed invention.

New dependent claim 17 simply breaks apart dependent claim 8, and depends from 1. Claim 17 is patentable over the relied upon art at least in view of its dependence from claim 1.

Other issues:

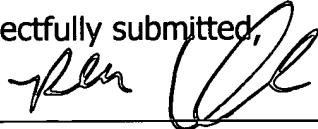
Applicants draw the Examiner's attention element 40 in Figure 1. RTC is an abbreviation for Reseau Téléphonique Commuté, which is translatable into English as a Public Switched Telephone Network. RNIS is an abbreviation for Réseau Numérique à Intégration de Services, which is translatable into English as an Integrated Services Digital Network. On this basis, Applicants propose to amend Figure 1 and the corresponding written description by substituting PSTN for RTC and ISDN for RNIS, no new matter being added in doing so.

Conclusion:

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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Respectfully submitted,


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23373
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Date: May 4, 2004